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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,722	04/16/2004	Russell F. McKnight	P1910US00	1771

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EXAMINER	
UBER, NATHAN C	

ART UNIT	PAPER NUMBER
4143	

MAIL DATE	DELIVERY MODE
01/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/826,722	MCKNIGHT ET AL.	
	Examiner	Art Unit	
	NATHAN C. UBER	4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☒ Claim(s) *4-9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 April 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *16 April 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 16 April 2004.

2. Claims 1-9 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on 16 April 2004 has been considered. One reference was listed with an incorrect patent number and was not considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Objections

4. Claims 4-9 are objected to because of the following informalities: claims 7-9 are verbatim duplicates of claims 4-5. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9:

Several terms used in claims 1-9 vague and indefinite and had inadequate support for their meaning in the specification. The indefinite terms and Examiner's interpretation of those terms are listed below.

- determining – the user indicates a distinction via a prompt or by the creation of a new profile or list
- aggregating – storing together in an orderly way so that it is retrievable later

Claims 4 and 7:

Language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack,* 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (bdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994). Claims 4 and 7 are directed to an apparatus which is a compilation of various components. The claims also recite *the memory storing instructions*. Data stored in memory is nonfunctional descriptive material because these limitations add little, if anything, to the claimed apparatus and it will not distinguish the claimed invention from the prior art in terms of patentability.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 3:

Claims 1 and 3 each recite a method. A method is a proper statutory category under 35 U.S.C. 101. However, in each of these claims there is a judicial exception because the content of the method claims are abstract ideas. The steps of the claims are purely theoretical. Method claims that are abstract ideas may only be deemed statutory subject matter if there is a practical application of the method embodied in the claims. The test for this is whether there is a physical transformation or whether there is a useful, concrete and tangible result. Here the claims do not produce a physical transformation because the steps are accomplished entirely mentally or within the processor of a computer. Further the claims do not produce a useful, concrete *and* tangible

result. The result of both claims is an aggregation of information. To be useful, a result must have specific, substantial *and* credible utility. See generally MPEP 2107.01. Here a *method for generating a profile distinction* does not disclose a specific or substantial utility. The method steps neither "provide[s] a well defined and particular benefit to the public" *In re Fisher*, 421 F.3d 1365, 1371, nor shows "a presently available benefit to the public," *Id.* The result is not concrete because it is not predictable and repeatable. As claimed the method depends on a first determination step in which the result is arbitrary. Finally the result is not tangible as there is no real world result; an 'aggregation of information' is an inherently abstract result. For the reasons detailed above there is no practical application of the judicial exception. Claims 1 and 3 are therefore rejected under 35 U.S.C. 101.

Claim 2:

Claim 2 is rejected for the reasons stated above because it is dependant on Claim 1 and is deemed to embody all of the limitations of Claim 1.

Claims 5-6 and 8-9:

Claims 5-6 and 8-9 are rejected because they are directed to *instructions.* Instructions are not statutory subject matter under 35 U.S.C. 101. Instructions are considered non-functional descriptive material. Here the claims are directed to an apparatus. A proper apparatus claim is directed to physical components like the *network interface, processor and memory* of claims 4 and 7. In apparatus claims no weight is given to limitations such as non-functional data stored within components. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-4, 6-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrett, (US 6,473,738 B1).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 1:

Garrett, as shown, discloses the following limitations:

- *determining if the computerized transaction is associated with the user or on behalf of a third party* (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),
- *aggregating information associated with the transaction in a profile corresponding to the user if the computerized transaction is determined to be associated with the user* (see at least column 3, lines 52-53, "saving the selection list"),
- *aggregating the information associated with the transaction in the profile corresponding to the user according to a profile distinction associated with the third party if the computerized transaction is determined to be associated with the third party* (see at least column 3, lines 52-53, "saving the selection list").

Claim 3:

Garrett, as shown, discloses the following limitations:

- *determining if the profile distinction associated with the third party is already present in the profile* (see at least column 6, line 42, the list of parties can be displayed),

- *establishing the profile distinction associated with the third party if the profile distinction is not already present in the profile* (see at least column 3, lines 46-47, generating... a list of names… the customer may associate items with),
- *aggregating the information associated with the transaction in the profile distinction associated with the third party if the profile distinction is already present in the profile* (see at least column 3, lines 52-53, "saving the selection list).

Claims 4 and 7:

Garrett, as shown, discloses the following limitations:

- *a network interface* (see at least Figure 4),
- *a processor* (see at least column 5, line 6, personal computer)
- *a memory coupled to the processor and the network interface* (see at least column 5, line 6, personal computer)
- *memory storing instructions for causing the processor to* (see at least column 5, line 9-11),
- *determine if the profile distinction associated with the third party is already present in the profile* (see at least column 6, line 42, the list of parties can be displayed),
- *establish the profile distinction associated with the third party if the profile distinction is not already present in the profile* (see at least column 3, lines 46-47, generating... a list of names… the customer may associate items with),
- *aggregate the information associated with the transaction in the profile distinction associated with the third party if the profile distinction is already present in the profile* (see at least column 3, lines 52-53, "saving the selection list).

Claims 6 and 9:

Garrett, as shown, discloses the following limitations:

- *determine if the profile distinction associated with the third party is already present in the profile* (see at least column 6, line 42, the list of parties can be displayed),

- *establish the profile distinction associated with the third party if the profile distinction is not already present in the profile* (see at least column 3, lines 46-47, generating... a list of names… the customer may associate items with),
- *aggregate the information associated with the transaction in the profile distinction associated with the third party if the profile distinction is already present in the profile* (see at least column 3, lines 52-53, "saving the selection list).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 2, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US 6,473,738 B1) in view of Jacobi et al. (US 7,113,917 B2).

Claims 2, 5 and 8:

Garrett discloses the limitations as shown in the rejections above. Furthermore Garrett, as shown, discloses the following limitations:

- *presenting a product offering tailored to one or more of the user and the third party using the aggregated information associated with the transaction* (see at least column 7, lines 39-40 shopping list, see also Figure 5).

Garrett does not disclose the following additional limitations, but Jacobi, as shown, does:

- *presenting one or more of a special offer, a promotion, a product recommendation, and a product suggestion tailored to one or more of the user and the third party using the aggregated information associated with the transaction* (see at least column 4, lines 55-61, implementing a variety of recommendation services… generates personal recommendations).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations (the invention of Jacobi) because the combination "will have a tendency to identify other [products] that are well suited for the gift recipient." (Jacobi, column 6, lines 20-21; Jacobi used books in this quote only as an example which is evident in the context of lines 18-22.)

Conclusion

14. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.270.6710**.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

16. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

17. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 4143
6 December 2007
/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143